



Patent Application
Docket No. PC9942C

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By

Kelly A. Smith
(Signature of person mailing)
Kelly A. Smith

(Typed or printed name of person)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Charles K. Chiu and

Lewin T. Wint

Serial No.: 10/087,756

Filed: March 4, 2002

Group Art Unit: 1625

Examiner: ROBINSON, Binta

For: A PROCESS FOR PREPARING
NAPHTHYRIDONES AND
INTERMEDIATES

12/17/2003 MDANTE1 00000121 161445 10087756

01 FC:1402 330.00 DA

BRIEF ON APPEAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

By Notice of Appeal, filed August 11, 2003, Appellants
have appealed the Final Rejection, dated July 9, 2003, of



FEE TRANSMITTAL for FY 2004

Effective 01/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small status. See 37 CFR 1.27

Total Amount of Payment (\$290.00)

Complete if Known

Application Number 10/087,756
Filing Date March 4, 2002
First Named Inventor Charles K. Chiu
Examiner Name Binta Robinson
Art Unit 1625
Attorney Docket No. PC9942C

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit
Account
Number

16-1445

Deposit
Account
Name

Pfizer Inc.

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, **except for the filing fee** to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

	Extra Claims	Fee from below	Fee Paid
Total Claims	-20**=	X	=
Independent Claims	-3**=	X	=
Multiple Dependent		=	

** or number previously paid, if greater; For Reissues, see below

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late fee or oath	
1052	50	2052	25	Surcharge-late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	290.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1801	770	2801	385	Request for Continued Examination (RCE)	
1806	180	1806	180	Submission of Information Disclosure Statement	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	

Other Fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 290.00

SUBMITTED BY

Name (Printed/Type) Scott Alexander McNeil

Signature

Date 12/11/03

Complete (if Applicable)

Reg. Number 37,185

Telephone (860)686-1848

Claims 8-11. Appellants submit this Brief, in triplicate, to support the Notice of Appeal.

Payment authorization, for filing this Brief On Appeal, is provided by the concurrently filed Transmittal Letter.

A request for a two-month extension of time, and the authorization for payment of the appropriate fee, is separately enclosed herewith.

I. Real Party in Interest

The present application, listing the Charles K. Chiu and Lewin T. Wint, is owned in its entirety by Pfizer Inc.

II. Related Appeals and Interferences

There are no other appeals or interferences, known to Appellants or Appellants' Attorney, relating to the present application, which will directly affect, be directly affected by, or have a bearing on the Board's decision on the pending appeal.

III. Status of Claims

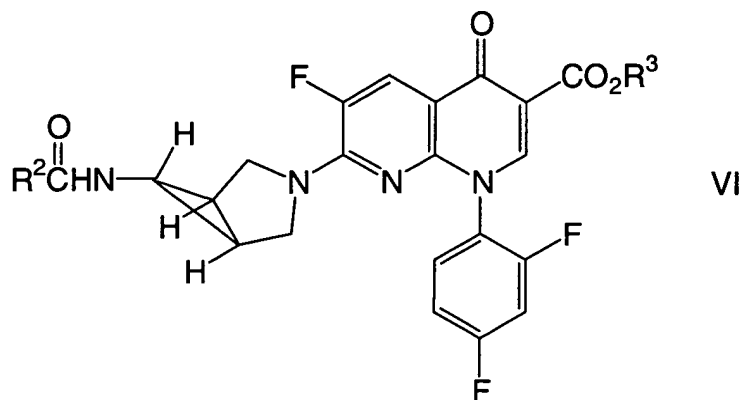
Claims 8-11 are currently pending in the present application. Claims 8-11, which are attached as Appendix A, are final rejected under 35 USC 112, first paragraph. Claim 8 also stands final rejected under 35 USC 112, second paragraph.

IV. Status of Amendments

No amendments have been filed in the present application subsequent to the final rejection.

V. Summary of the Invention

The present invention, as claimed in independent Claim 8, is directed to a method for making a compound having the structure of Formula IV, shown below.



wherein R^2 is C_1 - C_6 alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of C_1 - C_6 alkyl, C_1 - C_6 alkoxy, halo, nitro, amino or trifluoromethyl.

The invention of Claim 11 is directed to a compound of Formula VI.

VI. Issues

- A. Whether Claims 8-11 are properly rejected under 35 USC 112, first paragraph.
- B. Whether Claim 8 is properly rejected under 35 USC 112, second paragraph.

VII. Grouping of Claims

Claims 8-11 are one group. It is respectfully requested that the Board select Claim 8 to decide the appeal as to the grounds of the rejection of Claims 8-11.

VIII. Argument

A. A Rejection, Under 35 USC 112, First Paragraph, for not Enabling One Skilled in the Art to Make a Compound Having 3 or More Nitro or Amino Groups on a Phenyl Ring, Is Not Proper

Claims 8-11 are rejected under 35 USC §112, first paragraph, as not enabling one skilled in the art to make the invention. The Examiner states that while the Specification provides enablement for R² equaling 1 to 2 nitro, or amine, groups on the phenyl in a meta position, the Specification does not provide enablement for a phenyl R² group that is substituted 3 or more times with nitro or amino groups. Further, the Examiner states, without providing any basis of support, that no compound has ever been synthesized where a phenyl ring can support electron-withdrawing groups, such as nitro, in the ortho position.

Contrary to the Examiner's statement, the Specification does enable one of skill in the art to make and use the invention of Claims 8-11.

The purpose of the enablement provision is to assure that the inventor provides sufficient information about the claimed invention so that a person of skill in the art can make and use it without undue experimentation relying on the Specification and the knowledge in the art. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1896 (Fed. Cir. 1991).)

Contrary to the Examiner's statement, phenyl compounds, and processes, are known in the art for producing phenyl compounds that (1) are substituted at the ortho position with a nitro or amino group, and (2) are substituted 3 or more times with nitro and amino groups. Numerous examples

of such compounds are present in the American Chemical Society registry of compounds. In demonstration of this fact, 19 different structures, from the ACS Registry, are attached, in Appendix B, which show compounds containing phenyl groups that are substituted at the ortho position with a nitro or amine group and compounds containing phenyl groups that are substituted 3 or more times with nitro or amine groups. Thus, utilizing the known methods in the art for making these compounds, one of skill in the art would be able, without undue experimentation, to make compounds of Claims 8-11 wherein the R² group is a phenyl that is substituted at the ortho position and/or 3 or more times with nitro or amino groups.

Thus, pending Claims 8-11 are improperly rejected as being non-enabling.

B. A Rejection, Under 35 USC 112, Second Paragraph, for Being Indefinite in that the Phrase "One or More" is Indefinite and as a Phenyl Ring Cannot Support Electron-Withdrawing Groups in the Ortho Position, Is Not Proper

The Examiner states that, in Claim 8, the phrase "one or more C₁-C₆ alkyl, C₁-C₆ alkoxy, halo, nitro, amino or trifluoromethyl" is indefinite as there is no upper bound on the phrase "one or more".

Contrary to the Examiner's statement, the phrase "one or more" is not indefinite.

It is not required that an application describe claim limitations in detail greater than the invention warrants. (See *Martin v. Mayer*, 3 USPQ2d 1333 (Fed. Cir. 1987).) Rather, the application only needs description sufficient that it conveys to those skilled in the art that the

applicant has invented the subject matter claimed. (See *In re Kaslow*, 217 USPQ 1089, 1096 (Fed. Cir. 1983).)

In Claim 8, the phrase "one or more C₁-C₆ alkyl, C₁-C₆ alkoxy, halo, nitro, amino or trifluoromethyl" relates to possible substitution of the group R² wherein R² can be a C₁-C₆ alkyl, trifluoromethyl or phenyl. It is well within the knowledge of one skilled in the art how many times a methyl, ethyl, propyl, butyl, pentyl, hexyl, trifluoromethyl or phenyl group may be substituted with one of the above-identified substituents. Therefore, based upon the disclosure provided in the present Application, does sufficiently describe to a skilled artisan the scope of the presently claimed invention.

Further, phrases such as "one or more" or "at least one", as used in chemical claims, are clearly understood by the skilled artisan. The clear understanding and acceptance of such claim language, by the skilled artisan, is further demonstrated by US Patent No. 5,684,135 (Claim 1), US Patent No. 5,653,960 (Claim 1), and US Patent No. 5,532,242 (Claim 1).

The Examiner also made the baseless assertion that a phenyl ring cannot support an electron-withdrawing group, such as nitro, in the ortho position.

As previously described herein, in the response to the Examiner's rejection under 35 USC §112, first paragraph, the Examiner's statement is incorrect.

Thus, pending Claim 8 is improperly rejected as being indefinite under 35 USC 112, second paragraph.

IX. Conclusion

In view of the above information, present Claims 8-11 are not properly rejected under 35 USC 112, first or second

paragraphs. Therefore, it is respectfully requested that the rejections of Claims 8-11 be withdrawn and that Claims 8-11 be allowed.

Date: 11 December 2003

Respectfully submitted,

A handwritten signature in cursive script, reading "Scott Alexander McNeil", is written over a horizontal line.

Scott Alexander McNeil

Attorney for Appellants

Reg. No. 37,185

Pfizer Inc.

Patent Department, Box 519

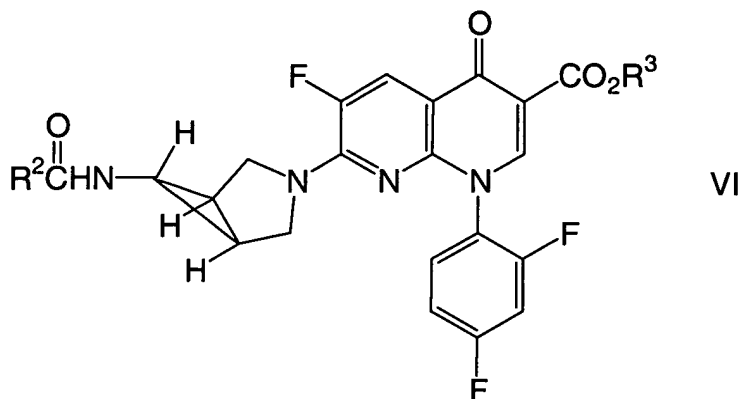
Eastern Point Road

Groton, Connecticut 06340

(860) 715-0871

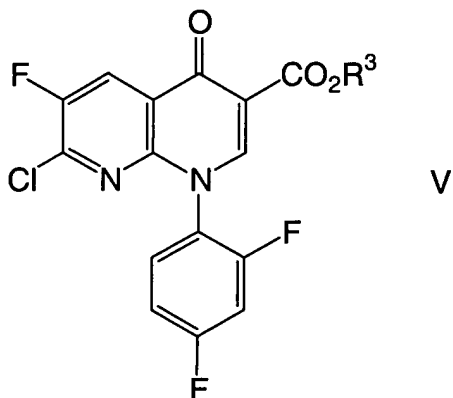
APPENDIX A
CLAIMS UNDER APPEAL

8. A process for the preparation of a compound of the formula

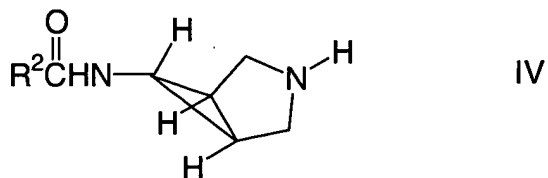


wherein R^2 is C_1 - C_6 alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of C_1 - C_6 alkyl, C_1 - C_6 alkoxy, halo, nitro, amino or trifluoromethyl, and

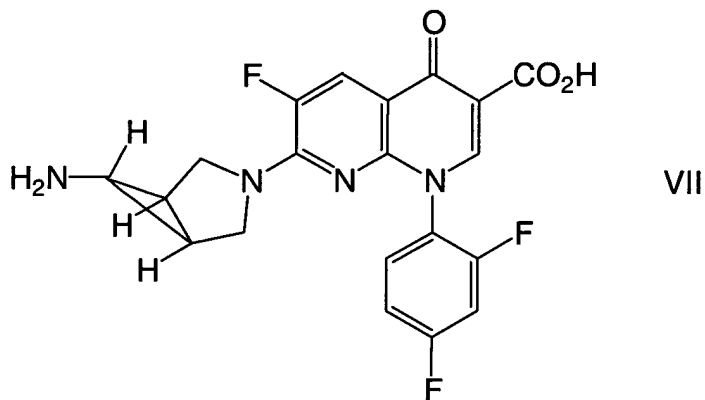
R^3 is C_1 - C_6 alkyl, which comprises reacting a compound of the formula



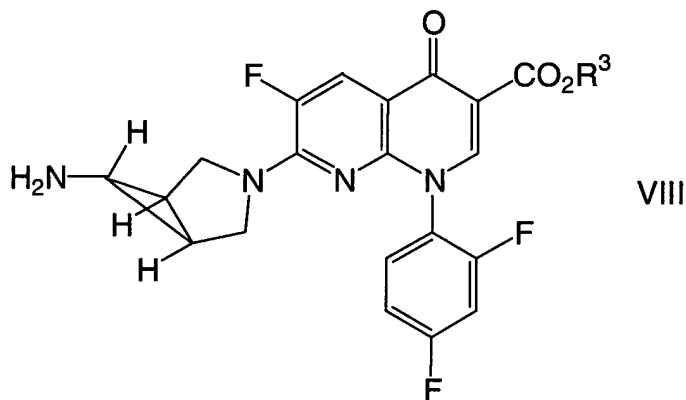
with a compound of the formula



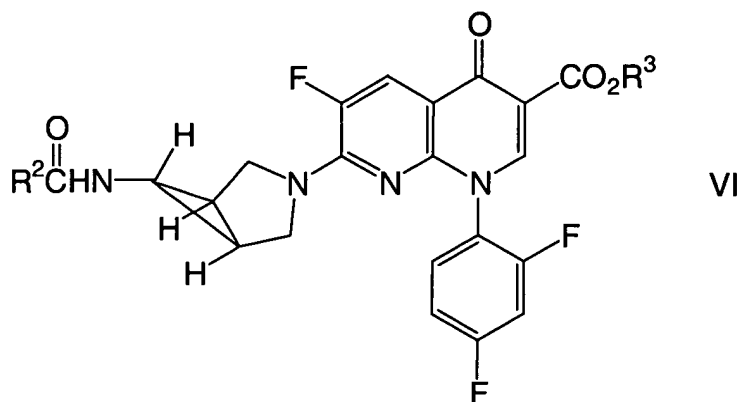
9. A process comprising hydrolysis of the compound of formula VI with methanesulfonic acid, water and an organic solvent to form a monomethanesulfonic acid salt of a compound of the formula



10. A process comprising hydrolysis of the compound of formula VI with methanesulfonic acid and R^3OH wherein R^3 is $\text{C}_1\text{-C}_6$ alkyl to form a monomethanesulfonic acid salt of a compound of the formula



11. A compound of the formula



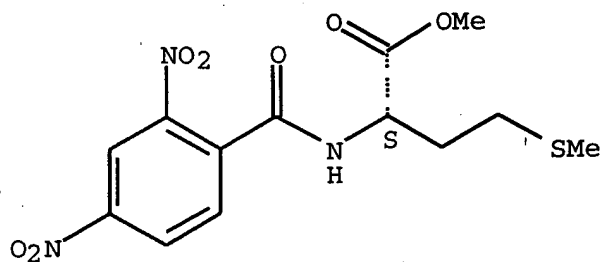
wherein

R^2 is C_1 - C_6 alkyl, trifluoromethyl, or phenyl which may be substituted by one or more of C_1 - C_6 alkyl, C_1 - C_6 alkoxy, halo, nitro, amino or trifluoromethyl, and

R^3 is C_1 - C_6 alkyl.

APPENDIX B

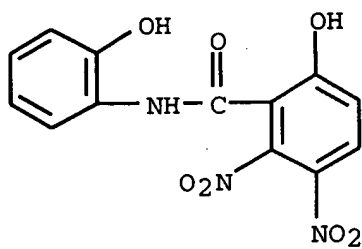
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Commercial Sources

No References

REGISTRY (Copyright 2003 ACS)

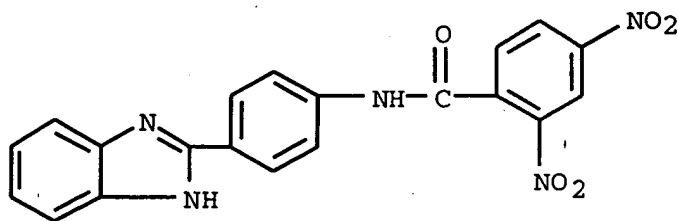
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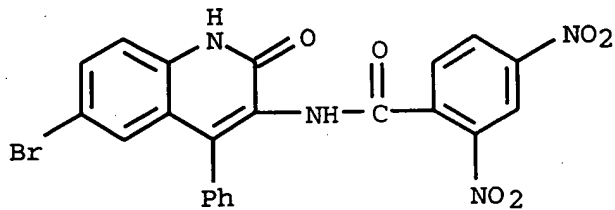
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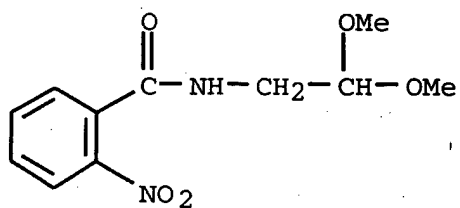
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**No References**

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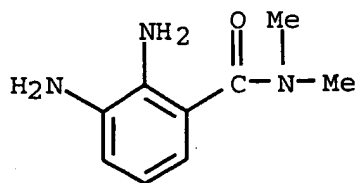
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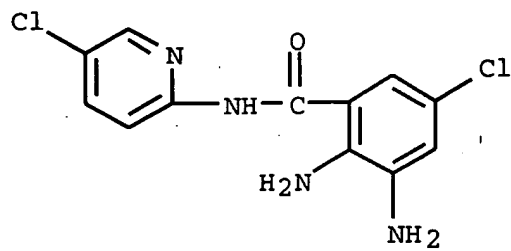
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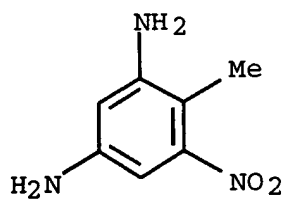
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~2 References

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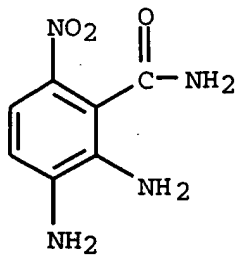
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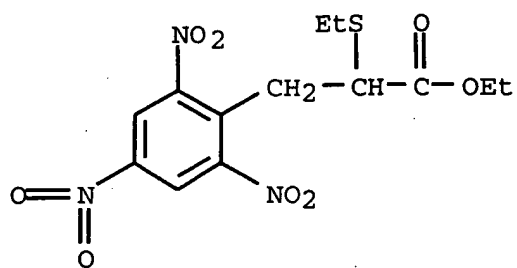
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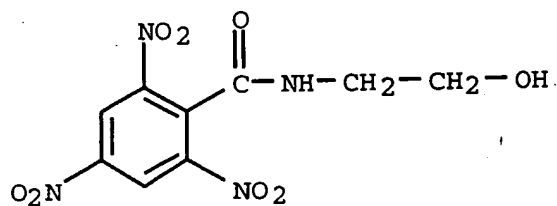
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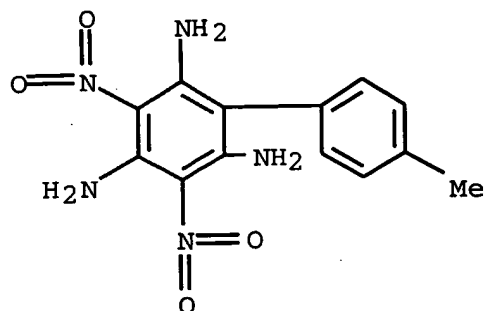
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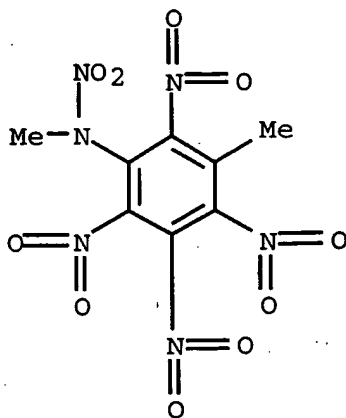
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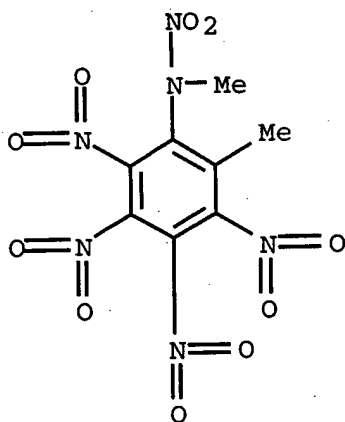
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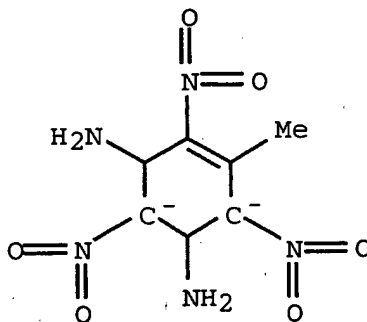
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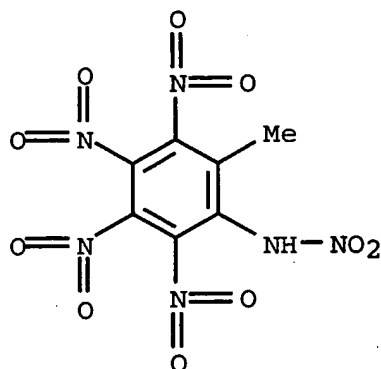
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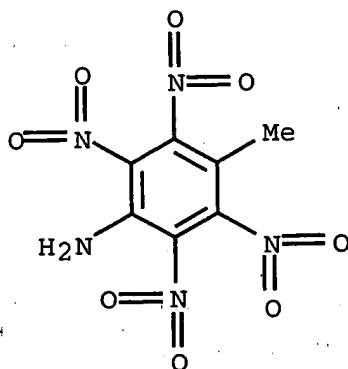
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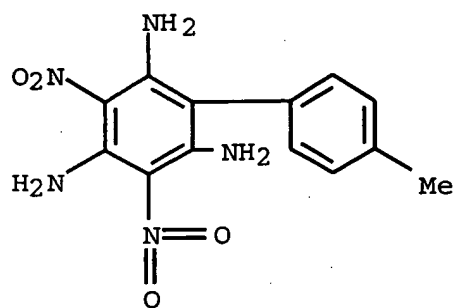
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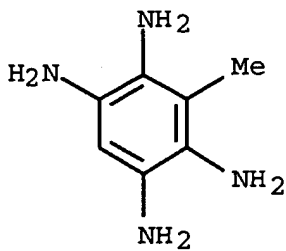
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No References

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